

REMARKS

In the Office Action of April 26, 2006, claims 1-40 and 69-74 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. Applicant respectfully traverses the rejection.

The Examiner states that the claims are indefinite for failing to provide specific compositions meeting the characteristics as set forth in the claims, and further alleges that the claims are functional since they cover any conceivable combination of ingredients, either presently existing or which might be discovered in the future.

Applicant respectfully responds that there is nothing inherently wrong with defining at least a part of the invention in functional terms. Functional language does not, in and of itself, render a claim improper or indefinite. See *In re Swinehart*, 169 U.S.P.Q. 226, 229 (C.C.P.A. 1971). Accordingly, applicant believes that the mere use of functional language does not render the claims unpatentable under 35 U.S.C. § 112.

The Office Action states that the claims do not provide specific compositions meeting the characteristics as set forth in the claims. Applicant submits that the present specification lists, without limitation, materials that may be used for preparing the absorbent articles of the invention (see, for instance, the specification at page 36, line 24 to page 37, line 7). Applicant believes that claims appropriately define the inventive aspects of the invention in accordance with the criteria selected by applicant. Applicant submits that, one skilled in the art, with the present specification as a guide, would have absolutely no difficulty in constructing or selecting absorbent articles falling within the ambit of the present claims. Accordingly, there is no basis for the proposition that the present claims cover any conceivable combination of ingredients.

Claims 1-40 and 69-74 have also been rejected under 35 U.S.C. § 102(b), as being anticipated by Yang (U.S. Patent No. 5,030,229). Applicant respectfully traverses the rejection.

Yang discloses a disposable urinary pad comprising a liquid-impermeable backing, an absorbent core, and a liquid permeable facing adhered to the shell of the pad. The absorbent core is formed from a web of fibers and super absorbent material having a liquid-permeable transfer layer adjacent to one surface thereof. The absorbent core of Yang is folded into an M-shaped configuration with a central lengthwise channel. This is intended to provide a liquid path to the bottom of the pad. See col. 3 of Yang.

According to the Examiner, "one can reasonably assume that the absorbent article of Yang would inherently provide the claimed test characteristics if subjected to a procedure identical to that disclosed by the Applicant." Applicant respectfully submits that a reasonable assumption may not make inherent the claimed test characteristics, and requests that the Examiner "provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily flows* from the teachings of the applied prior art." See *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 9B.P.A.I. 1990).

Additionally, the mere fact that other materials may meet the test criteria as disclosed in the present application does not amount to the present invention being anticipated by inherency. Instead, each and every element of the claim must be taught by the reference, which is not the case here. For example, Yang does not disclose the Distribution Index as shown in the present specification. "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Moreover, the M-shaped folded core design with the central channel structure of the reference is not part of the present invention. Finally, the reference is entirely silent regarding the invention disclosed in claims 69-74, wherein the Distribution Index for the first and second insult points are comparable.

In view of the aforementioned facts and reasons, the present application is now believed to overcome the remaining rejections in this application, and to be in proper condition for allowance. Reconsideration and withdrawal of the rejections, and allowance of the remaining claims of this application, are therefore respectfully solicited. The Examiner is invited to contact the undersigned at the telephone number listed below to discuss any matter pertaining to the status of this application.

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